

REMARKS

The Examiner is thanked for the performance of a thorough search.

Prior to this response, Claims 1-27 were pending in the application. By this response, Claims 14-26 are canceled and Claims 28-40 are added. Hence, Claims 1-13 and 27-40 are pending in the application upon entry of this response.

Claims 1-4, 6-12, and 27 are amended herein.

SUMMARY OF THE REJECTIONS/OBJECTIONS

Claims 1-27 were rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite;

Claims 14-26 were rejected under 35 U.S.C. §101 as allegedly directed to non-statutory subject matter; and

Claim 27 was rejected under 35 U.S.C. §101 as allegedly directed to non-statutory subject matter.

THE REJECTIONS NOT BASED ON THE PRIOR ART

Rejections under 35 U.S.C. §112, second paragraph

(I) Claims 1-27

Claims 1-27 were rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite. Specifically, the Office Action noted several instances of the pronoun “that” throughout the claims, with the assertion that the pronoun “that” is not permitted as part of the claim language.

Claims 1-4, 7-12, and 27 are amended herein to remove instances of the offending term “that” when used as a pronoun. Hence, this rejection of Claims 1-27 under 35 U.S.C. §112,

second paragraph is overcome, and reconsideration and withdrawal of this rejection is requested.

(II) Claims 14-26

Claims 14-26 were rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite. Specifically, a paraphrase of what the Office Action asserts is that “there cannot be any inconsistency between the preamble of the claim incorporated by reference and the claim containing the incorporation” or the claim containing the incorporation is unclear as to its metes and bounds and, therefore, is indefinite. Applicants respectfully disagree.

It is recognized that it may be somewhat uncommon for a dependent claim to have a different form than the claim on which it depends. However, such a practice is explicitly authorized by the MPEP. Furthermore, such a practice is accounted for in the PTO’s “Changes to Practice for the Examination of Claims in Patent Applications” (Federal Register/ Vol. 71, No. 1/ Tuesday, January 3, 2006/Proposed Rules; at the final paragraph of column 3 of page 63) in stating how to treat a claim that refers to a claim of a different statutory class, for fee calculation purposes. In fact, many patents have issued with this exact form of dependent claim, including:

- 6,711,567 (“Delivering non-default items in association with search results”)
- 6,661,877 (“System and method for providing access to a unified message store logically storing computer telephony messages”)
- 6,647,510 (“Method and apparatus for making available data that was locked by a dead transaction before rolling back the entire dead transaction”)
- 6,633,891 (“Managing replacement of data in a cache on a node based on caches of other nodes”)

- 6,631,371 (“Database fine-grained access control”)
- 6,130,677 (“Interactive computer vision system”)
- 6,031,934 (“Computer vision system for subject characterization”)

In all of these cases, the USPTO ultimately found the claims to be in proper dependent form.

Various tests have been established to determine whether a particular claim qualifies as a proper dependent claim. Significantly, none of the tests requires the dependent claim to fall within the same statutory class as the claim on which it depends. Specifically, MPEP §608.01(n) states, among other things:

The fact that the independent and dependent claims are in different statutory classes does not, in itself, render the latter improper. Thus, if claim 1 recites a specific product, a claim for the method of making the product of claim 1 in a particular manner would be a proper dependent claim since it could not be infringed without infringing claim 1. Similarly, if claim 1 recites a method of making a product, a claim for a product made by the method of claim 1 could be a proper dependent claim.

35 U.S.C. § 112 is the statutory section that sets forth the requirements of a proper dependent claim. In paragraph 4, 35 U.S.C. § 112 states:

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

The first sentence of this paragraph sets forth the two requirements for a proper dependent claim, and the second sentence sets forth the legal significance to the dependency.

With respect to the requirements, a proper dependent claim must (1) contain a reference to a claim previously set forth, and (2) specify a further limitation on the subject matter claimed.

Both of these requirements are clearly satisfied by Claims 14-26. Specifically, each of Claims 14-26 clearly contains references to Claims 1-13, respectively. In addition, each of Claims 14-

26 specifies the further limitation that instructions for performing the methods of Claims 1-13, respectively, must be stored on a computer-readable medium so that the methods would be performed when one or more processors execute the instructions. Since Claims 1-13 do not require that the methods be performed by executing stored instructions, the limitations added by Claims 14-26 qualify as further limitations.

Because Claims 14-26 are proper dependent claims, the second sentence of 35 U.S.C. §112, fourth paragraph indicates that Claims 14-26 are to be construed to incorporate by reference all the limitations of the claims to which they refer. Thus, in the present case, Claims 14-26 are to be construed to incorporate all limitations of the methods set forth in Claims 1-13, respectively. That interpretation of Claims 14-26 is consistent with Applicants' understanding of Claims 14-26. Specifically, to infringe Claims 14-26, a computer readable medium would have to include instructions for each and every step recited in the parent Claims 1-13, respectively.

The Office Action refers to MPEP 2173.02 for support for the assertion that "there cannot be any inconsistency between the preamble of the claim incorporated by reference and the claim containing the incorporation." However, support for such an assertion does not appear in this section of the MPEP. Further, it is noteworthy that MPEP 2173.02 does state that an examiner "should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness" and "should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement." It is submitted that one of ordinary skill in the art could readily discern the meaning of Claims 14-26 and, therefore, interpret the metes and bounds of the claim so as to understand how to avoid infringement.

However, in order to expedite prosecution, Claims 14-26 are canceled and new Claims 28-40 are added to claim the subject matter of Claims 14-26 in a format believed to be more suitable to the interpretation of U.S.C. §112, second paragraph set forth in the Office Action. Thus, the rejection of Claims 14-26 under U.S.C. §112, second paragraph, is now moot.

Rejections under 35 U.S.C. §101

(I) Claims 14-26

Claims 14-26 were rejected under 35 U.S.C. §101 as allegedly directed to non-statutory subject matter. Claims 14-26 are canceled herein and replaced with Claims 28-40. Claims 28-40 recite a “computer-readable storage medium” rather than a “computer-readable medium”, thereby clearly falling within the statutory category of an article of manufacture.

(II) Claim 27

Claim 27 was rejected under 35 U.S.C. §101 as allegedly directed to non-statutory subject matter. Specifically, the Office Action asserts that Claim 27 is directed specifically toward software, per se, made up of means, and that the software system constituting the system is not claimed as embodied in a computer. This rejection is traversed, based on the following reasons.

As is apparent based on the recitation of various means for performing corresponding functions, Claim 27 is to be considered under 35 U.S.C. §112, sixth paragraph, which dictates that Claim 27 is construed to cover “structure, material, or acts described in the specification ...” Hence, by definition, a claim reciting means for performing a function without recital of structure or material in support thereof *necessarily* includes structure or material, i.e., hardware, described in the specification. Reference is made to the computer system of FIG. 2 for an example of hardware means that can be used to implement the embodiment recited in Claim 27.

Furthermore, one skilled in the art understands that software cannot perform steps if not executed in hardware, such as executed by processor 204 of computer system 200 of FIG. 2. Nowhere in the specification is it implied that software is useable without hardware. Therefore, any proper interpretation of the various "means" of Claim 27, even in the context of software instructions for carrying out certain steps, necessarily includes hardware to execute software instructions. Additionally, one skilled in the art would have no problem with identifying what components of computer system 200 are suitable for use in executing computer-readable instructions. Thus, Claim 27 should be considered a statutory machine and/or article of manufacture. Reconsideration and withdrawal of the rejection of Claim 27 under U.S.C. §101 is requested.

CONCLUSION

For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

Please charge any shortages or credit any overages to Deposit Account No. 50-1302.

Respectfully submitted,

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